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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Shigeru Horiguchi : EXAMINER: MAHONEY, C

SERIAL NO: 09/840,107 :

FILED: APRIL 24, 2001 : GROUP: 2851

FOR: A CAMERA AND A PORTABLE APPARATUS
HAVING A FLAT BODY

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RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER OF PATENTS
WASHINGTON, DC 20231

SIR:

In response to the Restriction Requirement stated in the Official Action dated September 27, 2002, Applicant provisionally elects Group (Invention) II, Claims 32, 59-67 and 70, drawn to a camera with a grip, classified in class 396, subclass 540.

Applicant respectfully traverses the outstanding Restriction Requirement for several reasons.

First, the outstanding Office Action asserts that "[t]he inventions are distinct, each from the other" under MPEP §806.05(d), because "... invention I has separate utility such as for use in a camera with only one actuation button." However, without further information, such a finding lacks grounds upon which it can be evaluated whether in fact the alleged alternative is "separate utility" under MPEP §806.05(d). Accordingly, it is respectfully submitted that the PTO has not carried its burden of proof to establish distinctness.

Furthermore, MPEP § 803 states the following:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

In the present application, Claims 1, 10, 21 and 32 are directed to cameras, Claims 33 and 35 to methods of making cameras, Claims 39, 48, 59 and 68-70 to portable apparatus with photographing functions, and Claims 71 and 73 to methods of making portable apparatus with photographing functions. Also, according to the Office Action, all the claims are classified within the same class. Hence, it appears that the claims in the present application are part of an overlapping search area and that a search for Claims 32, 59-67 and 70 would necessarily include the subclass required for a search directed to the rest of the claims as well. It is therefore believed that there is no undue burden on the Examiner to search all the claims under MPEP §803, and Applicants respectfully traverse the Restriction Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Therefore, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 1-76 be conducted.

Respectfully submitted,

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